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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/668,973	09/24/2003	Takashi Yano	240117US-2 CONT	1462

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EXAMINER
AHN, SANGWOO

ART UNIT	PAPER NUMBER
2168	

NOTIFICATION DATE	DELIVERY MODE
02/03/2009	ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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	Application No.	Applicant(s)
Office Action Summary	10/668,973	YANO ET AL.
	Examiner	Art Unit	
	SANGWOO AHN	2168	

-- *The MAILING DATE of this communication appears on the cover sheet with the correspondence address* --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS,
WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed
  after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any
  earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) ☒ Responsive to communication(s) filed on *11/19/2008*.

2a) ☒ This action is FINAL.   2b) ☐ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is
closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) ☒ Claim(s) *2-9,11-22 and 24-34* is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5) ☐ Claim(s) _____ is/are allowed.

6) ☒ Claim(s) *2-9,11-22 and 24-34* is/are rejected.

7) ☐ Claim(s) _____ is/are objected to.

8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) ☐ The specification is objected to by the Examiner.

10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a) ☐ All   b) ☐ Some * c) ☐ None of:

      1. ☐ Certified copies of the priority documents have been received.

      2. ☐ Certified copies of the priority documents have been received in Application No. _____.

      3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage
         application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)

2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
    Paper No(s)/Mail Date _____.

4) ☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____.

5) ☐ Notice of Informal Patent Application

6) ☐ Other: _____.

DETAILED ACTION

Response to Amendment

Claims 2 – 9, 11 – 22 and 24 – 34 are pending in the current application.

Claim 31 has been amended.

Claims 1, 10 and 23 have been canceled.

Response to Arguments

Applicant's arguments filed on 11/19/2008 have been fully considered but they are not persuasive.

It seem that Applicant's main contention is that 35 USC 103(a) rejection is improper since the suggested combination of Chess and Kamper would destroy the purpose of Chess's system, rendering it meaningless.

Examiner respectfully traverses the arguments. Kamper's feature of identifying a word of the image as a keyword prior to performing a search using the keyword can be combined with other features of Chess, thus providing a method that enables document search function in response to a keyword selection in a document. Applicant is arguing as if performing search function before a user can select a keyword to display pertinent documents is the sole feature of Chess's entire invention. However, this is merely one of many features disclosed by Chess. The benefit of "saving user's time and effort" can be achieved by many means other than performing search function prior to user's keyword selection. The foresaid benefit can be also achieved by combining other

features of Chess, such as displaying a pop-up menu including selectable documents, with the feature disclosed by Kamper. For example, while "performing search function prior to user's keyword selection" may take a long time since the system is searching for documents related to all words contained in the image, Kamper's search function after selection of a keyword and a search option can significantly reduce the amount of time and processing cost by narrowing the search category. Thus, combining Chess with Kamper would NOT destroy the purpose of Chess's system, which is to save user's time and effort.

Examiner also disagrees with the Applicant's contention that the suggested combination would destroy the functioning of Chess's system. The argument seems to amount to a general allegation without specifically pointing out how the "combination" of Chess and Kamper would not be functional. Applicant seems to argue that adding Kamper's feature would replace one of the features of Chess, thus rendering Chess's invention inoperable. Such argument is unpersuasive since what is most important in 35 USC 103(a) "obviousness" rejection is whether the "combination of references as a whole" would have been obvious to a person of ordinary skill in the art. In other words, as long as "the combination of Chess and Kamper" seems to be reasonable (motivation wise) and functional, Examine contends that the rejection is proper and sustainable.

For the foregoing reasons, 35 USC 103(a) rejections of the pending claims are hereby sustained.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

<u>Claims 2 - 9, 11 – 22 and 24 – 34 are rejected under 35 U.S.C. 103(a) as</u>

<u>being unpatentable over U.S. Patent Number 5,794,235 issued to David Michael</u>

<u>Chess (hereinafter "Chess") in view of U.S. Patent Number 5,982,370 issued to</u>

<u>Robert J. Kamper (hereinafter "Kamper").</u>

■ With respect to claim 2, Chess discloses,

A method of managing information comprising:

identifying, by a user, from all words in an image, a word of an image as a

keyword (column 2 lines10 – 11: isolates and identifies all the possibly-relevant words;

49 – 50: user can select one of the highlighted tokens, et seq.);

determining a search result corresponding to the keyword (column 2 lines 22 –

25: looks up token in a searchable database containing information that is likely of

interest to the user; 52 – 54: list related documents, et seq.);

displaying, on a display unit, a pop-up menu prepared based on a content of the

search result, the pop-up menu including a list of selectable documents corresponding

to the content of the search result (column 2 lines 52 – 54: present a list of the names of

related documents, et seq.); and

displaying additional information in response to a selection of a document in the list of documents in the pop-up menu (column 2 lines 59 – 62: retrieve full contents of the document, et seq.).

Chess does not explicitly indicate that identification of a word of an image as a keyword is prior to performing a search using the keyword.

However, Kamper clearly discloses identifying a word of an image as a keyword prior to performing a search using the keyword in Figure 5b, column 2 lines 36 – 40, column 3 lines 13 – 19, column 6 lines 42 – 49, column 7 lines 3 – 5, et seq. At the time the invention was made, it would have been obvious to a person of ordinary skill in the data processing art to modify Chess's method of managing documents to incorporate Kamper's method of identifying a keyword prior to performing a search, thus enabling a novel interface to an interactive search tool, offering users a convenient way to select keywords to save user's time and effort.

■ As to claim 3,

Chess teaches wherein the image is displayed on a display unit (column 2 lines 3 – 4, et seq.).

■ As to claim 4,

Chess teaches wherein the additional information is displayed on a display unit (column 2 line 63, et seq.).

■ As to claim 5,

Chess teaches wherein the step of displaying additional information is performed without altering a file corresponding to the image (column 2 line 63, et seq.).

■ As to claim 6,

Chess teaches selecting, after the step of displaying information and before the step of displaying additional information, the portion of the displayed information (column 2 lines 59 – 60, et seq.).

■ As to claim 7,

Chess teaches determining the search result using a search engine accessible by a browser (column 2 lines 27 – 29, et seq.).

■ As to claim 8,

Chess teaches wherein the step of identifying a word is performed using a pointing device (column 2 lines 50 – 51, et seq.).

■ As to claim 9,

Chess teaches wherein the step of identifying a word is performed using a cursor position (column 2 lines 50 – 51, et seq.).

■ As to claim 11,

Chess teaches wherein the identified word is a non-linked word (column 2 line 50, et seq.).

■ As to claim 12,

Chess teaches wherein, when a file is displayed on a display unit, a word from the file is identified as the keyword specified by a cursor on the display unit (column 2 lines 10 – 12; 22 – 23, et seq.).

■ As to claim 13,

Kamper teaches displaying, on a display unit, in a space adjacent to the keyword, a menu comprising menu items for specifying search criteria for a search engine (Figure 5c, column 2 lines 47 – 50, column 3 lines 18 – 19, et seq.); and

specifying the menu item by a cursor, wherein the keyword and the menu items specified are input into the search engine (Figure 5c, column 2 lines 47 – 50, column 3 lines 18 – 19, et seq.).

■ As to claim 14,

Chess teaches wherein the menu is for specifying at least one search database (column 2 lines 27 – 29, et seq.).

■ As to claim 15,

Kamper teaches displaying, on a display unit, in a space adjacent to the keyword, a menu for specifying output criteria of the search result (Figure 5c, column 2 lines 47 – 50, column 3 lines 18 – 19, et seq.).

■ As to claim 16,

Chess teaches wherein the menu is for specifying where to output the search result (column 2 lines 27 – 29; 49 – 54; 60 – 67, et seq.).

■ With respect to claim 17, Chess discloses an information management device, comprising:

a display unit configured to display an image (column 2 lines 3 – 4, et seq.);

an identification unit configured to identify, from all words in the displayed image, based on user input, a word displayed in the image to be a keyword (column 2 lines 10 – 11; 49 – 50, et seq.); and

a search unit configured to input the keyword and to output a search result corresponding to the keyword (column 2 lines 22 – 25; 52 – 54, et seq.),

wherein the display unit is configured to obtain the search result corresponding to the keyword from the search unit, to display a pop-up menu prepared based on a content of the search result, the pop-up menu including a list of selectable documents corresponding to content of the search results (column 2 lines 52 – 54, et seq.), and to display additional information in response to a selection of a document in the list of documents in the pop-up menu (column 2 lines 59 – 62, et seq.).

Chess does not explicitly indicate that identification of a word of an image as a keyword is prior to performing a search using the keyword.

However, Kamper clearly discloses identifying a word of an image as a keyword prior to performing a search using the keyword in Figure 5b, column 2 lines 36 – 40, column 3 lines 13 – 19, column 6 lines 42 – 49, column 7 lines 3 – 5, et seq. At the time the invention was made, it would have been obvious to a person of ordinary skill in the data processing art to modify Chess's method of managing documents to incorporate Kamper's method of identifying a keyword prior to performing a search, thus enabling a novel interface to an interactive search tool, offering users a convenient way to select keywords to save user's time and effort.

■ As to claim 18,

Chess teaches a selection unit configured to receive an input from a user who selects a portion of the displayed information (column 2 lines 49 – 50, et seq.); and at least one database for storing therein at least one file (column 2 line 28, et seq.).

■ As to claim 19,

Chess teaches wherein said search unit is a search engine accessible by a browser (column 2 lines 27 – 29, et seq.).

■ As to claim 20,

Chess teaches wherein the identification unit is configured to identify the word using a pointing device (column 2 lines 50 – 51, et seq.).

■ As to claim 21,

Chess teaches wherein the identification unit is configured to identify the word using a cursor position (column 2 lines 50 – 51, et seq.).

■ As to claim 22,

Chess teaches wherein the display unit is configured to display the additional information without altering a file corresponding to the image on the display unit (column 2 line 63, et seq.).

■ As to claim 24,

Chess teaches wherein the identification unit is configured to identify a non-linked word (column 2 line 50, et seq.).

■ As to claim 25,

Chess teaches when a file comprising a hypertext file or a non-hypertext file is displayed on the display unit, the identification unit is configured to identify a word from the file as the keyword specified by the cursor on the display unit (column 2 lines 50 – 51, et seq.).

■ As to claim 26,

Chess teaches a search criteria specification unit configured to display, on the display unit, in a space adjacent to the keyword, a menu for specifying search criteria for the search unit, the menu comprising menu items to be specified by a cursor; and a transfer unit configured to transfer the keyword and the menu items specified to the search unit (column 2 lines 10 – 12; 22 – 23, column 2 lines 27 – 29; 49 – 54, et seq.).

■ As to claim 27,

Chess teaches wherein the menu is for specifying at least one search database (column 2 lines 27 – 29, et seq.).

■ As to claim 28,

Chess teaches an output criteria specification unit configured to display, on the display unit, in a space adjacent to the keyword, a menu for specifying output criteria of the search result (column 2 lines 27 – 29; 49 – 54; 60 – 67, et seq.).

■ As to claim 29,

Chess teaches wherein the menu is for specifying where to output the result of the search (column 2 lines 27 – 29; 49 – 54; 60 – 67, et seq.).

■ Claims 30 – 31 are rejected based on the same rationale discussed in claim 2 rejection.

■ As to claim 32,

Chess teaches displaying text corresponding to the search result as text in the pop-up menu (column 2 lines 52 – 58, et seq.).

■ As to claim 33,

Chess teaches determining text to be displayed in the pop-up menu, wherein the text corresponds to documents searched in obtaining the search result (column 2 lines 52 – 58, et seq.).

■ As to claim 34,

Chess teaches wherein text displayed in the pop-up menu varies according to the content of the search result (column 2 lines 52 – 58, et seq.).

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to SANGWOO AHN whose telephone number is (571)272-5626. The examiner can normally be reached on M-F 10-6.

      If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, Tim Vo can be reached on (571) 272-3642. The fax phone number for the

organization where this application or proceeding is assigned is 571-273-8300.

      Information regarding the status of an application may be obtained from the

Patent Application Information Retrieval (PAIR) system. Status information for

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Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a

USPTO Customer Service Representative or access to the automated information

system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Tim T. Vo/   1/23/2009
Supervisory Patent Examiner, Art Unit 2168   /Sangwoo Ahn/
                                                              Examiner, Art Unit 2168